



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,479	06/19/2000	Jean-Christophe Audonnet	454313-2200.1	6603

20999 7590 03/21/2002

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

MOSHER, MARY

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 03/21/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/596,479

Applicant(s)
Audonnet et al

Examiner
Mosher

Art Unit
1648



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/19/2000, 11/13/2000, 8/18/2000, 4/26/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/213,053.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: Sequence Notice

Art Unit: 1648

DETAILED ACTION

Sequence Rules

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Compliance is required. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,159,477. Although the

Art Unit: 1648

conflicting claims are not identical, they are not patentably distinct from each other because claims 1-15 encompass the previously patented subject matter, and claim 16 is an obvious intermediate used in the construction of the patented herpesviruses.

Claim Rejections - 35 USC § 112

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear if the claim is directed to a virus or a vaccine composition. This affects claims 2-15.

Claim 4 is indefinite in reciting “preferably”.

Claim 11 is confusing for recitation of “from the groups of sequences corresponding to...”, the metes and bounds of sequences that “correspond” have not been defined.

Claim 13 is confusing for reciting a Markush group with only one member, “cytokines.”

Claim 16 is vague and indefinite for recitation of “fragment” the metes and bounds of fragment(s) is/are not defined. In addition, recitation of “DNA fragment” is unclear, is Isolated DNA consisting of SEQ ID NO: 1 intended? Claim 16 is also unclear in reciting “a part” of SEQ ID NO.1. Is the intent to claim a single nucleotide?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1648

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Limbach et al (J of General Virology, 1994). See Figure 2.

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Remond et al (Virus Research, 1995). See Figure 3.

Claim 16 is rejected under 35 U.S.C. 102(a) as being anticipated by Remond et al (J of General Virology, 1996 Jan). See Figure 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 9, 11, 12, 15, 16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haanes et al (US Patent No. 5,753,235 or 5,804,197).

Art Unit: 1648

Haanes discloses in great detail the construction and formation of canine herpesvirus (CHV) as an expression vector to be utilized in a vaccine delivery system in animals wherein a heterologous antigen or antigens or immunomodulatory substance may be inserted in various well defined non-essential regions of the CHV to be utilized as a vaccine delivery system, and claims the resulting viruses and body-treating compositions comprising the viruses (see especially claims 12-16, 48-57 of '235 and claims 16-51 of '197). Thus, the disclosure and the teaching of the above cited patent teaches each and every limitation of the claims. It is noted that the patent does not contain a working example of vaccine compositions. However Haanes explicitly suggests vaccine compositions comprising the herpesviruses, and it would have been within the ordinary skill of the art to carry out the explicit suggestions of the reference, with reasonable expectation of success. The invention as a whole is therefore prima facie obvious, if not anticipated by the reference.

Claims 6, 10, 13, -14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haanes et al (US Patent No.5,753,235 or 5,804,197). The patents do not specifically teach Carre's disease virus or cytokines for incorporation in a recombinant CHV, or teach multigene constructs involving diverging promoters or IRES sequences. However, the patents very broadly teach insertion of antigens of canine pathogens and of immunomodulatory materials. Therefore it would have been obvious to choose an antigen of another canine pathogen, or to choose a cytokine as an immunomodulatory material. The patents broadly teach expression of foreign sequences, and it would have been obvious to choose known arrangements of foreign expression

Art Unit: 1648

cassettes, including diverging promoters and IRES sequences known for the purpose of conveniently introducing two foreign sequences into the same site. The invention as a whole is therefore seen as prima facie obvious, absent unexpected results.

Information Disclosure Statement

The documents which were not provided in parent application 09/713,053 have not been considered.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 20, 2002



MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800

1000